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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,530	02/11/2002	Kevin M. Liga	043978-075000	6699
22204	7590	01/14/2008		
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER LE, KHANH H	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 01/14/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/074,530	LIGA ET AL.	
	Examiner	Art Unit	
	Khanh H. Le	3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 and 32-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/23/2004;  
03/04/2005; 01/09/2006; .

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### DETAILED ACTION

1. This Office Action is responsive to the correspondence of 10/15/2007. Applicants elected Invention 3 directed to claims 25-31 without traverse (withdrawing claims 1-24, and 32-41). Thus claims 25-31 are herein examined. Claim 25 is independent.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. **Claim 25 is rejected under 35 U.S.C. 102(e) as being anticipated by Miller US 7266832.**

Claim 25:

Miller discloses:

A method for providing targeted advertising, comprising:

compiling consumer profile information (col.8 lines 3-24: profiles of opted-in consumers or of non-opted ones for ads targeting);

determining whether a first advertisement matches the consumer profile information (col.8 line 22: ad targeting suggests matching with profiles); in the event that the first advertisement matches the consumer profile information, recording the first advertisement at the consumer location (col. 8 lines 25-38) onto a personal video recorder (col. 4 lines 21-23) ; and in the event that the first advertisement does not match the consumer profile information, ignoring the first advertisement (inherent).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller as applied to claim 25 above, and further in view of Lazaridis US 7076244.**

Claim 26:

Miller discloses the method of claim 25 including recording the first advertisement at the consumer location (col. 8 lines 25-38) onto a personal video recorder (PVR) (col. 4 lines 21-23) but does not disclose how to locate the first advertisement for recording to the PVR. That is Miller does not disclose determining whether the first advertisement is broadcast by a transmission center on a dedicated frequency; and if so, tuning a receiver to the dedicated frequency; if not, then scanning a set of broadcast frequencies to locate the first advertisement.

However, in analogous ad targeting art, Lazaridis teaches locating an appropriate ad targeted to a user by scanning many broadcast channels (Fig. 7 step 308 and associated text; col. 13 lines 34-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add that teaching of Lazaridis to Miller to allow locating an appropriate targeted ad when it is not known where the ad is located. It would also have been obvious to one skilled in the art that in the alternative, if a dedicated channel is known to provide such targeted ad, to tune a receiver to that channel, since that would have been a more efficient method to locate the ad.

Claims 27 and 28:

The combination of MILLER and LAZARIDIS discloses the method of claim 26 and MILLER further discloses:

playing a programming signal (col. 8 lines 39-44);

detecting a second advertisement in the programming signal (Figure 4 step 58;

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col. 8 lines 56-65) which has embedded data comprising information indicating the contents of the second advertisement. (MILLER 's TV signal ads, col. 1 lines 50-53, have embedded data indicating the ads contents, e.g. a URL of the ad, see col. 1 lines 19-24, 28-38);

*(note: embedding ad contents is also admitted art, e.g. specifications, US PGPub 2003/0154128 at [0023]; [0053])*

determining whether the second advertisement should be swapped (Fig. 4 step 60; col. 8 lines 56-65) based on whether the second advertisement matches the consumer information profile (col. 8 lines 12-16 reads on determining that the second advertisement do not match the opted-in subscribers so swapping is necessary);

in response to determining that the second advertisement does not match the consumer information profile, retrieving the first advertisement; inserting the first advertisement in the programming signal; and playing the first advertisement (Fig. 4 step 62; col.9 lines 14-21, 28-35).

#### Claims 29-31:

The combination of MILLER and LAZARIDIS modified as above discussed discloses the method of claims 27 or 28 and but does not specifically disclose wherein the step of determining whether the second advertisement matches the consumer information profile comprises: receiving and reviewing the embedded data; and comparing the contents of the second advertisement to the consumer information profile.

However it would have been obvious to one of ordinary skill in the art at the time the invention was made that the claimed steps would have been necessary to effect claims 27 and 28 as discussed above.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Beach US 6728713, Barton US 6490722 disclose insert/replace/update ads in programs with targeted ads, tivo types devices.

Landesmann 6735572 and Cox 7058223 disclose embedding in ads. Landesmann discloses recording for-rewards-ads on Tivo type devices.

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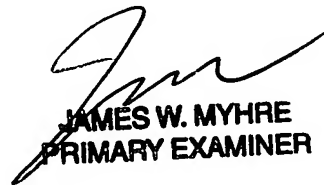
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday-Wednesday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

January 4, 2008

KHL



**JAMES W. MYHRE**  
**PRIMARY EXAMINER**